

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Kenneth A. Scott et al.
Application No. : 10/616,779 Confirmation No. : 2000
Filed : July 10, 2003
For : SIMULCAST PARI-MUTUEL GAMING MACHINE
WITH CASINO AND LOTTERY STYLED WAGERS
FOR CONTINUOUS PLAY
Group Art Unit : 3714
Examiner : Paul Anthony D'Agostino

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection of October 29, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS**I. THE EXAMINER FAILS TO ESTABLISH A *PRIMA FACIE* CASE OF LACK OF
ENABLEMENT OF ANY OF THE CLAIMS**

The Examiner rejects the pending claims under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. In particular, the Examiner asserts that

[i]n Claim 21 for example, there are presented a first option and a selection of the first option and a second option and a selection of the second option, however, only the second option is received from the player. There is no further claim language to address receiving of the first option by the player. Office Action, paragraph 2, page 2

First, Applicants note that MPEP § 2172.01 states that a rejection for “a claim which omits matter disclosed to be essential to the invention” is to be made under 35 U.S.C. § 112, first paragraph, as not enabling. Applicants will proceed under the assumption that the rejection of the claims is made under 35 U.S.C. § 112, first paragraph, not 35 U.S.C. § 112, second paragraph, as asserted by the Examiner.

Second, claim 21, for example, recites “*displaying to the player at least a first option and a second option,*” recites a description of the first option and the second option (i.e., “*wherein a selection of the first option; and a selection of the second option ...*”), and recites “*receiving from the player a selection of the second option.*” Contrary to the Examiner’s apparent assertion, claim 21 does not recite “a selection of the first option [by the player].”

Third, regarding the assertion that claim 21, for example, omits the alleged essential step of “receiving of the first option by the player,” the Examiner fails to establish a *prima facie* case of lack of enablement. Specifically, according to MPEP § 2172.01, essential steps must be described by the applicant(s) as necessary to practice the invention. Nowhere have the alleged essential steps been described as necessary to practice the invention. The Examiner’s failure to establish a *prima facie* case of lack of enablement results in clear error.

**II. THE EXAMINER FAILS TO ESTABLISH A *PRIMA FACIE* CASE OF
OBVIOUSNESS OF ANY OF THE CLAIMS**

The Examiner rejects the pending claims under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al., U.S. Patent 5,830,068 (hereinafter Brenner) in view of Mir et al., U.S. Patent 6,450,887 (hereinafter Mir).

In a determination of obviousness, the Examiner must support all factual findings with substantial evidence of record. In re Zurko, 258 F.3d 1379, 1383-84 and 86 (Fed. Cir. 2001). The Supreme Court has reiterated that mere conclusory statements are insufficient on which to base a conclusion of obviousness. JKS Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-42 (S.Ct. 2007). Even the MPEP clearly articulates that an obviousness rejection must be based on factual findings supported by substantial evidence of record. See MPEP §§ 2141(I) and 2144.03.

The Examiner fails to provide evidence of record, let alone substantial evidence of record, to support the rejection of the claims. As clearly articulated by the MPEP, and by the Supreme Court and the Federal Circuit, examiner statements unsupported by any evidence of record are insufficient to establish a *prima facie* case of obviousness. The Examiner's failure to establish a *prima facie* case of obviousness of any of the claims results in clear error.

a. The Examiner fails to provide any evidence of record to support the Examiner's assertions regarding the purported state of the prior art

In rejecting independent claim 21 (and apparently independent claims 29 and 37) regarding the limitations of the claim, the Examiner asserts in part:

Brenner as modified by Mir is silent wherein player selection of a different game than the first game at the first track without redisplaying to the player the track selection frame. However, one of ordinary skill in the art would recognize that the natural progression in the art of gaming and on-line virtual wagering would improve the robustness of the design by providing increased player options in the form of more selections and choices. If a player is at one virtual location (at one virtual track) and wishes to either select a different game, track, or other feature then it would only require only routine skill in the art to make more play variations available.

It would therefore be obvious to one of ordinary skill in the art at the time the invention was made to allow a player to choose a new game without leaving his chosen track because of the ability to make more play variations available. Office Action, paragraph 6, pages 5.

The Examiner fails to provide any evidence of record, let alone substantial evidence of record, to support the Examiner's assertions regarding the purported state of the prior art, or to support the Examiner's purported motivation for combining alleged features of Brenner and Mir with alleged features of the prior art in the manner recited by the claims. On the contrary, the Examiner's statements are purely conclusory. As clearly articulated by the MPEP, and by the Supreme Court and the Federal Circuit, examiner statements unsupported by any evidence of 03-7113_090429_PreAppeal-Conf-Request

record are insufficient to establish a *prima facie* case of obviousness. Accordingly, the Examiner fails to establish a *prima facie* case of obviousness of independent claims 21, 29, and 37, and of claims 22-28, 30-36, and 38-40, which depend there from.

b. The Examiner fails to provide any evidence of record to support the Examiner's purported motivation for combining the references

In rejecting independent claim 21 (and apparently independent claims 29 and 37), the Examiner asserts in part:

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the betting options disclosed in Brenner with the ability to first select a desired game and display a plurality of tracks where the selected game is available, as disclosed by Mir, the inventions are analogous race-track type betting systems in the same field of endeavor. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Office Action, paragraph 6, pages 4-5.

The Examiner fails to provide any evidence of record to support the Examiner's assertion that one of ordinary skill in the art would have been motivated to combine alleged features of Brenner and Mir in the manner recited by the claims merely because Brenner and Mir are allegedly "analogous ... systems in the same field of endeavor." Similarly, the Examiner fails to provide any evidence of record to support the Examiner's various assertions regarding one skilled in the art. Again, as articulated by the MPEP, and by the Supreme Court and the Federal Circuit, Examiner statements unsupported by any evidence of record are merely conclusory and are insufficient to establish a *prima facie* case of obviousness. Accordingly, the Examiner fails to establish a *prima facie* case of obviousness of independent claims 21, 29, and 37, and of claims 22-28, 30-36, and 38-40, which depend there from.

c. The Examiner fails to set forth in the written record any factual findings of how the references disclose all the limitations of dependent claims 22-28, 30-36, and 38-40

To establish a *prima facie* case of obviousness of a claimed invention, the Examiner must show that all limitations of a claim are taught or suggested by the prior art. Further, the MPEP reads in part:

When making an obviousness rejection, **Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied....**

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. **35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.** MPEP § 2141(II) (bold emphasis added).

In rejecting the dependent claims, including claims **22-28, 30-36, and 38-40**, the Examiner merely asserts that the rejection of independent claim **21** is representative of these claims. Office Action, paragraph 6, page 3. However, the dependent claims recite limitations not recited by claim **21** (e.g., claim **23** and similarly, claims **31** and **39**, recite “*receiving from the player a selection of the instructional option*” and in response thereto, “*displaying to the player the explanation frame*,” wherein the explanation frame includes “*a plurality of rules for playing the first game; and at least one simulated play of the first game*”). Accordingly, the Examiner’s rejection of claim **21** does not include factual findings by the Examiner as to how the references disclose all the limitations of the dependent claims. Because the Examiner fails to set forth in the written record factual findings of how the references disclose all the limitations of the dependent claims, the Examiner fails to establish a *prima facie* case of obviousness of these claims.

In addition, Applicants are unable to respond to the rejection of at least the dependent claims because the Examiner fails to notify Applicants of the Examiner’s basis for the rejection. As important, Applicants are not required to guess at the Examiner’s position.

III. CONCLUSION

The Examiner’s failure to establish a *prima facie* case of lack of enablement and obviousness of any of the claims results in clear error. Withdrawal of the rejection is requested.

Respectfully submitted,

April 29, 2009
Date

/Glen R. Farbanish/
Glen R. Farbanish
Reg. No. 50,561
(212) 294-7733/phone